

## **Remarks**

### **Brief Review of the Office Action**

In the Office Action, claims 16-22 were rejected under 35 USC 101 as being directed to non-statutory subject matter. Claims 1, 16, 17, and 19 were rejected as being anticipated by Case et al. Additionally, claims 1, 2, 9-10, 13-16, and 18-20 were rejected under USC 102(b) as being anticipated by ADSM Concepts.

### **Rejections Cited Under 35 USC 101**

Claims 16-22 were rejected as being directed towards “software per se,” and thus directed to non-statutory material. However, when functional computer programs are recorded on a computer-readable medium, the subject matter becomes statutory. The following is an excerpt from MPEP 2106.01

Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)(discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer efficiency) and >*In re Warmerdam*, 33 F.3d \*>1354,< 1360-61, 31 USPQ2d \*>1754,< 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory).

Claim 16 has been modified to clarify that the functional descriptive material is recorded onto a computer readable medium. “Having a program” has been replaced with “tangibly embodying a program of machine-readable instructions,” in order to clarify the relationship between the functional program and the medium for storing the functional program. Applicants submit that the computer readable medium referenced in claims 16-22 is statutory.

### **Rejections Cited Under 35 USC 102(b)**

Claims 1, 16, 17, 19, 20 were rejected as being anticipated by Case et al (6,847,987). However, with an appropriate showing under 37 CFR 1.131(b), Applicants may overcome the prior art rejections constituted under 35 U.S.C 102(e) by showing due diligence prior to the filing date of the cited prior art.

An official IBM document has been attached hereto to establish due diligence on the application. The notes are dated May 8, 1998, as indicated on page 7 of the attached document. The document is directed towards the subject matter in the claims of the current invention. Specifically, page 8 discloses the ability for “a Storage Management client to operat[e] remotely via browser.” Page 9 further discloses the use of “java applets” and “distributed APIs,” establishing that the subject matter of the patent application in question was developed prior to May 8, 1998.

Claims 1, 2, 9-10, 13-16, and 18-20 were rejected as being anticipated by ADSM concepts. Although there are references to ADSM concepts in several Tivoli documents published by IBM, Applicants were unable to find the specific reference cited by the examiner. According to 707.05(a) Copies of Cited References [R-3] - 700 Examination of Applications, the examiner is required to furnish the reference. The version number of the document, and the reference location would be helpful in establishing both the context and time frame of the cited prior art.

## **CONCLUSION**

Applicants assert that rejections under USC 101, 102(b), have been overcome by the amendments made to the claims. Applicants assert that the claims are now in condition for allowance, pending receipt of the ADSM concepts reference. In the event any questions remain, the Examiner is respectfully requested to initiate a telephone conference with the undersigned.

Respectfully submitted,

Date: June 10, 2008

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